

## **REMARKS**

### **A. BACKGROUND**

The present Amendment is in response to the Office Action mailed October 30, 2008. Claims 1-10, 13-17, 19, 21-23, 26, and 27 were pending and rejected in view of cited art,<sup>1</sup> and claims 3, 4, 9, 10, 13, 14, and 19 were previously withdrawn. Claims 3, 4, 9, 10, 13, 14, and 19 are canceled, claims 1, 2, 15-17, 21, and 22 are amended, and new claims 28-32 are added. Claims 1, 2, 5-8, 15-17, 21-23, and 26-32 are now pending in view of the above amendments.<sup>2</sup>

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicant requests that the Examiner carefully review any references discussed below to ensure that Applicant's understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

### **B. PRIOR ART REJECTIONS**

#### **I. REJECTION UNDER 35 U.S.C. § 103**

The Office Action rejected claims 1, 2, 5, 6, 15-17, and 21-23 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,882,335 (*Leone*) in view of U.S. Patent No. 5,443,498 (*Fontaine*) and U.S. Patent No. 6,071,305 (*Brown*). Claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Leone* in view of *Fontaine* and *Brown* as applied to claim 1 and further in view of U.S. Publication No. 2002/0038146 (*Harry*)(also patented as 7,052,488). Claims 26 and 27 were rejected under 35 U.S.C. § 103(a) as being

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<sup>1</sup> Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should the need arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

<sup>2</sup> Support for the claim amendments and/or new claims can be found throughout the specification and drawings as originally filed.

unpatentable over *Leone* in view of *Fontaine* and *Brown* as applied to claim 1 and further in view of U.S. Publication No. 2003/0083646 (*Sirhan*). Applicant respectfully traverses.

As currently amended, independent claims 1 and 23 recite, in part, a stent having "a plurality of tubular members, each tubular member being formed into a circumferential ring"; and independent claim 15 recites, in part, "forming a first tubular member . . . into a first circumferential ring . . . forming a second tubular member . . . into a second circumferential ring . . . [and] forming a stent from the circumferential rings by coupling . . . the first circumferential ring to the . . . second circumferential ring."

As the Office Action correctly notes, *Leone* "fail[s] to explicitly disclose the stent is a plurality of tubular members with circumferential rings having upper peaks connected to lower peaks of adjacent tubular members." (Office Action 3.) However, the Office Action asserts that *Fontaine* teaches "a stent with a plurality of tubular members having circumferential rings with the peaks and valleys of adjacent rings coupled together" and that it would have been obvious to one of ordinary skill in the art to modify *Leone* "to have a plurality of circumferential rings." (*Id.*) Applicant respectfully disagrees.

In particular, *Fontaine* does not disclose, teach, or suggest a plurality of tubular members. Rather, in direct contrast, *Fontaine* teaches a stent "includ[ing] a continuous wire which is formed into a substantially tubular body." (Abstract.) Specifically, the "stent is formed from a continuous wire shaped into the planar pattern or waveform illustrated in FIG. 6." (Col. 5, ll. 53-55; see also Figure 6.) The stent is then "formed by wrapping the waveform of FIG. 6 around a mandril." (Col. 6, ll. 36-37; see also Figure 7.)

Applicant respectfully submits that the "continuous wire" stent of *Fontaine* is not the same as a stent including "a plurality of tubular members, each tubular member being formed into a circumferential ring," as recited, in part, by claims 1 and 23. Similarly, forming the "continuous wire" stent of *Fontaine* is not the same as "forming a first tubular member . . . into a first circumferential ring . . . forming a second tubular member . . . into a second circumferential ring . . . [and] forming a stent from the circumferential rings by coupling . . . the first circumferential ring to the . . . second circumferential ring," as recited, in part, by claim 15. Therefore, *Fontaine* does not disclose, teach, or suggest each and every element of claims 1, 15, and 23. Furthermore, the Office Action does not cite, and Applicant has not found, any portion of the remaining cited prior art references that remedies the deficiencies of *Fontaine* with respect to independent claims 1, 15, and 23. Accordingly, the cited prior art references, whether

individually or in combination, fail to disclose, teach, or suggest each and every element of the pending claims.

In addition, it would not have been obvious to one of ordinary skill in the art to make the proposed modification of *Leone* because it would render *Leone* unsatisfactory for its intended purpose. "If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MANUAL OF PATENT EXAMINING PROCEDURE § 2143.01V (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). *Leone* teaches "a hollow tubular wire stent which extends in a path defining a generally cylindrical envelope and which has side walls facing outwardly . . . with holes therein for delivery of liquid to a site in a vessel." (Abstract.) "[A] liquid delivery tubing 24 has a distal end portion 25 fixed to a proximal end 26 of the hollow metal tubular wire stent 12," while "a distal end 27 of the stent 12 is closed." (Col. 3, ll. 19-23.) "The hollow nature of the stent 12, 60 or 70 allows the stent 12, 60 or 70 to be loaded at the time of implantation with a solution of whatever drug the user wishes delivered." (Col. 5, ll. 30-33.) As a result, "[o]nce the stent 12 is implanted . . . a drug . . . can be injected through the delivery tubing 24 to the hollow stent 12 and then out the holes 29 in the outer periphery of the stent 12 for treating the stenotic area." (Col. 3, ll. 61-65.)

Modifying the "hollow tubular wire stent" of *Leone* to include "a plurality of tubular members, each tubular member being formed into a circumferential ring," as recited, in part, by claims 1 and 23, would actually prevent the flow of liquid from the "liquid delivery tubing 24" through the "hollow stent 12 and then out the holes 29" as taught by *Leone*. Therefore, the proposed modification would render *Leone* unsatisfactory for its intended purpose, thereby making it unobvious to one of ordinary skill in the art.

Therefore, because the cited prior art references fail to disclose, teach, or suggest each and every element of independent claims 1, 15, and 23, and because the proposed modification of *Leone* would actually render *Leone* unsatisfactory for its intended purpose, Applicant respectfully requests that the rejection of claims 1, 15, and 23 under § 103 be withdrawn. Furthermore, the pending dependent claims are allowable for at least the same reasons claims 1, 15, and 23 are allowable.

**C. CONCLUSION**

In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as provide the required motivation or suggestion to combine references with the other art of record.

For at least the foregoing reasons, Applicant respectfully submits that the pending claims are neither anticipated by nor made obvious by the art of record. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 25th day of February, 2009.

Respectfully submitted,

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